

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF NEW YORK

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CANON, INC.,

Plaintiff,

-against-

ORDER
18 CV 1277 (ENV) (CLP)

HONG KONG BOZE CO. LTD.,

Defendant.

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POLLAK, United States Magistrate Judge:

On February 28, 2018, plaintiff Canon, Inc. filed its Complaint alleging claims of patent infringement against defendant Hong Kong BoZe Co. Ltd. (See generally Compl., Feb. 28, 2018, ECF No. 1). The Complaint specifically alleges that this action is related to a matter currently pending before the U.S. International Trade Commission (the “ITC”) because both actions involve the same parties, patents, and products. (See id. ¶ 1).

On April 4, 2018, defendant filed its unopposed motion to stay this action. (See generally Def.’s Mot., Apr. 4, 2018, ECF No. 6). According to the defendant, a stay is mandatory under 28 U.S.C. § 1659(a) because on March 26, 2018, the ITC named the defendant in this case as a respondent in a proceeding before the ITC, Certain Toner Cartridges and Components Thereof, Inv. No. 337-TA-1106, 83 Fed. Reg. 13516 (USITC Mar. 26, 2018) (initiation). (See id. ¶ 4).

The statutory provision cited by defendant provides that:

In a civil action involving parties that are also parties to a proceeding before the [ITC] under section 337 of the Tariff Act of 1930, at the request of a party to the civil action that is also a respondent in the proceeding before the Commission, the district court shall stay, until the determination of the Commission becomes final, proceedings in the civil action with respect to any claim that involves the same issues involved in the proceeding before the [ITC], but only if such

request is made within (1) 30 days after the party is named as a respondent in the proceeding before the Commission, or (2) 30 days after the district court action is filed, whichever is later.

28 U.S.C. § 1659(a). The ITC proceeding names the plaintiff in this action as a complainant and the defendant in this action as a respondent. See Certain Toner Cartridges and Components Thereof, 83 Fed. Reg. 13516. Moreover, the defendant filed the motion less than 30 days after it was named as a respondent in the ITC proceeding, and the motion is therefore timely. See id.

Defendant has satisfied the prerequisites to a stay under 28 U.S.C. § 1659(a), and defendant's unopposed motion to stay is therefore granted. To the extent service has not been completed, it may proceed, but otherwise this action is STAYED pursuant to 28 U.S.C.

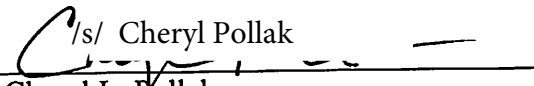
§ 1659(a) with respect to all claims, counterclaims, cross-claims, defenses, and other assertions pertaining to the infringement and/or validity of the following: (1) U.S. Patent No. 9,746,826, (2) U.S. Patent No. 9,836,021, (3) U.S. Patent No. 9,841,727, (4) U.S. Patent No. 9,841,728, (5) U.S. Patent No. 9,857,765, (6) U.S. Patent No. 9,869,960, and (7) U.S. Patent No. 9,874,846.

This Stay shall remain in effect until the determination of the proceeding before the ITC becomes final or until further Order of this Court. The parties are directed to file a Status Report by October 8, 2018.

The Clerk is directed to send copies of this Order to the parties either electronically through the Electronic Case Filing (ECF) system or by mail.

SO ORDERED.

Dated: Brooklyn, New York
April 5, 2018


Cheryl L. Pollak
United States Magistrate Judge
Eastern District of New York